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REMARKS

Amendments to the Claims

Applicants presently cancel system claims 7-11 and 19-24. Applicants also cancel computer program product claims 12 and 25-30, leaving only method claims in the present application. In amending the claims in the present application, Applicants do not concede that the claims as originally filed were not in a condition for allowance nor do these cancellations represent a disclaimer of the recited subject matter. Rather, Applicants reserve the right to pursue these cancelled system and product claims in one or more continuation applications. Applicants believe themselves entitled to pursue these claims in additional applications because the system and product claims are directed to an invention in a different statutory category than are the method claims that remain in this application. Applicants believe they are entitled to have claims directed to inventions in separate statutory categories issued in separate patents.

Applicants presently amend claims 1 and 13 to include limitations previously found in dependent claim 5 of Applicants' original application. As such, Applicants currently cancel claim 5 in the present application. Applicants submit that these amendments do not introduce any new matter into the specification and submit that the claims as currently amended are in condition for allowance.

Claim Rejections - 35 U.S.C. § 103 Over Farris, Bajwa, and Bassenyemukasa

Claims 1-17, 19-23, 25-29, and 32 stand rejected for obviousness under 35 U.S.C. § 103(a) as being unpatentable over Farris (U.S. Patent 6,122,357) in view of Bajwa (U.S. Patent Publication 2007/0058787 A1), and further in view of Bassenyemukasa (U.S. Patent No. 5,623,539). The question of whether Applicants claims are obvious or not is examined in light of: (1) the scope and content of the prior art; (2) the differences between the claimed invention and the prior art; (3) the level of ordinary skill in the art; and (4) any relevant secondary considerations, including commercial success, long felt but unsolved needs, and failure of others. *KSR Int'l Co. v. Teleflex Inc.*, No. 04-1350, slip

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op. at 2 (U.S. April 30, 2007). Although Applicants recognize that such an inquiry is an expansive and flexible one, the Office Action must nevertheless demonstrate a prima facie case of obviousness to reject Applicants claims for obviousness under 35 U.S.C. § 103(a). *In re Khan*, 441 F.3d 977, 985-86 (Fed. Cir. 2006). To establish a prima facie case of obviousness, the proposed combination of Farris, Bajwa, and Bassenyemukasa must teach or suggest all of Applicants' claim limitations. *Manual of Patent Examining Procedure* § 2142 (citing *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974)). As shown below in more detail, the proposed combination of Farris, Bajwa, and Bassenyemukasa cannot establish a prima facie case of obviousness because the proposed combination of Farris, Bajwa, and Bassenyemukasa does not teach each and every element of the claims of the present application. The rejection of claims 1-17, 19-23, 25-29, and 32 should therefore be withdrawn and the claims should be allowed. Applicants respectfully traverse each rejection individually and request reconsideration of claims 1-17, 19-23, 25-29, and 32.

The Proposed Combination Of Farris, Bajwa, And Bassenyemukasa Does Not Teach Or Suggest Each And Every Element Of Claim 1 Of The Present Application

To establish a prima facie case of obviousness under 35 U.S.C. § 103 the reference must teach or suggest all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). Independent claim 1 of the present application, as amended in this Response, recites:

1.   A method for specifying telephone services for a particular caller, comprising:

detecting a call initiation condition from an origin device at a trusted telephone network:

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brokering a connection between said origin device and an external server enabled to perform a caller identity authentication service, wherein brokering a connection further comprises:

transmitting a request for said caller identity authentication service via a signal gateway to a network for accessing said external server;

transferring a prompt for a voice utterance, received from said external server via a media gateway that supports Session Initiation Protocol ('SIP'), to said origin device;

transferring a voice utterance by said caller through said media gateway to said network for accessing said external server; and

receiving said authenticated caller identity via said signal gateway at said trusted telephone network;

responsive to receiving, from said external server, an authenticated caller identity of a caller utilizing said origin device, specifying services available to said caller according to said authenticated caller identity; and

responsive to said authenticated caller identity indicating a lack of identity, automatically initiating recording of said call.

As explained in more detail below, the combination of Farris, Bajwa, and Bassenyemukasa as proposed in the Office Action does not teach or suggest each and every element of claim 1 as claimed in the present application. Applicants therefore

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respectfully traverse each rejection individually and request that the rejections be withdrawn.

Farris Does Not Teach Or Suggest Transferring A Prompt For A Voice Utterance, Received From Said External Server Via A Media Gateway That Supports Session Initiation Protocol ('SIP'), To Said Origin Device

Claim 1 of the present application is amended to include the following limitation: transferring a prompt for a voice utterance, received from said external server via a media gateway that supports Session Initiation Protocol ('SIP'), to said origin device. The limitation above includes limitations previously recited in dependent claim 5 of Applicants' original application, as well as limitations recited in Applicants' original specification. In rejecting claim 5 of Applicants' original application, the Office Action relies upon Farris column 19, lines 43-46, as disclosing transferring a prompt for a voice utterance through a media gateway. Applicants respectfully note in response, however, that what Farris column 19, lines 43-46 actually discloses is:

> The signal received by the IP 23 goes over the lines and through the central office switch(es) for presentation via the off-hook telephone 1.sub.A to the calling party. In response, the caller will speak identifying information into their off-hook telephone, and the network will transport the audio signal to the IP 23 (step S11).

That is, the cited reference point discloses a user that speaks information into a telephone, and the information is subsequently transmitted to an Intelligent Peripheral. The cited reference point, however, does not teach or suggest transferring a prompt for a voice utterance, received from said external server via a media gateway that supports Session Initiation Protocol ('SIP'), to said origin device as claimed in the present application because Farris does not teach transferring anything via a media gateway that supports Session Initiation Protocol ('SIP'). In fact, Figure 1 of Farris illustrates that all components involved in identity authentication communicate via TCP/IP or SS7, not SIP as claimed in the present application. In fact, the term SIP does not even appear in Farris – not even once. Because Farris does not disclose transferring a prompt for a voice utterance, received from said external server via a media gateway that supports Session

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Initiation Protocol ('SIP'), to said origin device, the proposed combination of references does not teach or suggest each and every element and limitation of Applicants' claims.

In addition to the fact that Farris does not disclose transferring a prompt for a voice utterance, received from said external server via a media gateway that supports Session Initiation Protocol ('SIP'), to said origin device, the cited combination of references also does not teach or suggest transferring a voice utterance by said caller through said media gateway to said network for accessing said external server as claimed in the present application. Transferring a voice utterance by said caller through *said media gateway* to said network for accessing said external server, as claimed in the present application, includes transferring an utterance through the media gateway claimed above - a media gateway that supports Session Initiation Protocol ('SIP'). Because Farris does not teach such a gateway, the cited combination of references cannot teach or suggest transferring a voice utterance by said caller through said media gateway to said network for accessing said external server as claimed in the present application. The proposed combination of Farris, Bajwa, and Bassenyemukasa therefore cannot be used to establish a prima facie case of obviousness against Applicants' claims and the rejections should be withdrawn.

The Proposed Combination Of Farris And Bajwa
Does Not Teach Or Suggest Each And Every
Element Of Claim 13 Of The Present Application

To establish a prima facie case of obviousness under 35 U.S.C. § 103 the reference must teach or suggest all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). Independent claim 13 of the present application, as amended in this Response, recites:

13.   A method for informing a callee of a caller identity, comprising:

detecting a call initiation condition from an origin device at a
trusted telephone network;

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brokering a connection between said origin device and an external server enabled to perform a caller identity authentication service, wherein brokering a connection further comprises:

transmitting a request for said caller identity authentication service via a signal gateway to a network for accessing said external server;

transferring a prompt for a voice utterance, received from said external server via a media gateway that supports Session Initiation Protocol ('SIP'), to said origin device;

transferring a voice utterance by said caller through said media gateway to said network for accessing said external server; and

receiving said authenticated caller identity via said signal gateway at said trusted telephone network;

responsive to receiving, from said external server, an authenticated caller identity of a caller utilizing said origin device, transferring said authenticated caller identity to a destination device, such that a callee receiving said call at said destination device is provided with an identity of a party originating said call; and

responsive to said authenticated caller identity indicating a lack of identity, automatically initiating recording of said call.

As explained in more detail below, the combination of Farris, Bajwa, and Bassenyemukasa as proposed in the Office Action does not teach or suggest each and every element of claim 13 as claimed in the present application. Applicants therefore

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respectfully traverse each rejection individually and request that the rejections be withdrawn.

Farris Does Not Teach Or Suggest Transferring A Prompt For A Voice Utterance, Received From Said External Server Via A Media Gateway That Supports Session Initiation Protocol ('SIP'), To Said Origin Device

Claim 13 of the present application is amended to include the following limitation: transferring a prompt for a voice utterance, received from said external server via a media gateway that supports Session Initiation Protocol ('SIP'), to said origin device. The limitation above includes limitations previously recited in dependent claim 5 of Applicants' original application, as well as limitations recited in Applicants' original specification. In rejecting claim 5 of Applicants' original application, the Office Action relies upon Farris column 19, lines 43-46, as disclosing transferring a prompt for a voice utterance through a media gateway. Applicants respectfully note in response, however, that what Farris column 19, lines 43-46 actually discloses is:

> The signal received by the IP 23 goes over the lines and through the central office switch(es) for presentation via the off-hook telephone I.sub.A to the calling party. In response, the caller will speak identifying information into their off-hook telephone, and the network will transport the audio signal to the IP 23 (step S11).

That is, the cited reference point discloses a user that speaks information into a telephone, and the information is subsequently transmitted to an Intelligent Peripheral. The cited reference point, however, does not teach or suggest transferring a prompt for a voice utterance, received from said external server via a media gateway that supports Session Initiation Protocol ('SIP'), to said origin device as claimed in the present application because Farris does not teach transferring anything via a media gateway that supports Session Initiation Protocol ('SIP'). In fact, Figure 1 of Farris illustrates that all components involved in identity authentication communicate via TCP/IP or SS7, not SIP as claimed in the present application. In fact, the term SIP does not even appear in Farris – not even once. Because Farris does not disclose transferring a prompt for a voice utterance, received from said external server via a media gateway that supports Session

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Initiation Protocol ('SIP'), to said origin device, the proposed combination of references does not teach or suggest each and every element and limitation of Applicants' claims.

In addition to the fact that Farris does not disclose transferring a prompt for a voice utterance, received from said external server via a media gateway that supports Session Initiation Protocol ('SIP'), to said origin device, the cited combination of references also does not teach or suggest transferring a voice utterance by said caller through said media gateway to said network for accessing said external server as claimed in the present application. Transferring a voice utterance by said caller through *said media gateway* to said network for accessing said external server, as claimed in the present application, includes transferring an utterance through the media gateway claimed above - a media gateway that supports Session Initiation Protocol ('SIP'). Because Farris does not teach such a gateway, the cited combination of references cannot teach or suggest transferring a voice utterance by said caller through said media gateway to said network for accessing said external server as claimed in the present application. The proposed combination of Farris, Bajwa, and Bassenyemukasa therefore cannot be used to establish a prima facie case of obviousness against Applicants' claims and the rejections should be withdrawn.

Relations Among Claims

Claims 2-4, 6, and 14-17 depend from independent claims 1 and 13. Each dependent claim includes all of the limitations of the independent claim from which it depends. Because the combination of Farris, Bajwa, and Bassenyemukasa does not teach or suggest each and every element of the independent claims, so also the combination of Farris, Bajwa, and Bassenyemukasa cannot possibly teach or suggest each and every element of any dependent claim. The rejections of claims 2-4, 6, and 14-17 should therefore be withdrawn and these claims also should be allowed.

Conclusion

Claims 1-4, 6, and 13-17 stand rejected for obviousness under 35 U.S.C. § 103 as being unpatentable over the combination of Farris, Bajwa, and Bassenyemukasa. For the

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reasons set forth above, however, the proposed combination of Farris, Bajwa, and Bassenyemukasa cannot be used to establish a prima facie case of obviousness against claims 1-4, 6, and 13-17 of the present application. The rejection of claims 1-4, 6, and 13-17 under 35 U.S.C. § 103 should therefore be withdrawn and the claim should be allowed. Applicants respectfully request reconsideration of claims 1-4, 6, and 13-17.

The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

Respectfully submitted,

Date: July 1, 2008   By: _____

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